

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. RICHARDS

Appeal No. 1999-2342
Application No. 08/855,556

ON BRIEF

Before KRASS, DIXON, and GROSS, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 22-26 and 36-38, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a combined heat filter and condenser lens as a single optical element in a projection type apparatus. An understanding of the invention can be derived from a reading of exemplary claim 22, which is reproduced below.

22. A projection apparatus comprising:

- 1) a light source;
- 2) a support for supporting an object to be projected;
- 3) a single optical component spaced from and situated on one side of said support, said optical component being an integral condenser lens element and heat absorbing filter; and
- 4) a projection lens situated on the other side of said support.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|---------|-----------|---------------|
| Dey | 4,118,761 | Oct. 03, 1978 |
| Iwasaki | 5,046,838 | Sep. 10, 1991 |
| Merko | 5,353,211 | Oct. 04, 1994 |

Swanson, "Binary Optics Technology: The Theory and Design of Multi-Level Diffractive Optical Elements," Massachusetts Institute of Technology Lincoln Laboratory, Technical Report 854, pp. 1-47, Aug. 14, 1989.

Claim 22 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Iwasaki. Claims 23-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Iwasaki in view of Swanson. Claims 23-26 and 36-38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dey in view of Merko.¹ In the answer, the examiner has withdrawn the rejection under 35 U.S.C. § 112, second paragraph.

¹ We note that the examiner has not rejected independent claim 22 under the combination of Dey and Merko, but we assume that this is merely an oversight because the limitations of claim 22 must be met to reach the dependent claims 23-25, 36 and 37.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No.17, mailed Apr. 13, 1999) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 16, filed Jan. 25, 1999) and reply brief (Paper No. 18, filed Jun. 15, 1999) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 102

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Appellant argues that Iwasaki does not teach the use of a "single" optical component being an integral condenser lens and heat absorbing filter. (See brief at page 4 and reply brief at pages 5-10.) We agree with appellant. While Iwasaki discloses that the elements of the condenser may also be made of heat absorbing material, Iwasaki discloses a combination of components making up the condenser system. (See Iwasaki at column 3, lines 3-9, and 41-46.) Therefore, Iwasaki does not disclose a "single" component with both characteristics. Therefore, the examiner has not established a **prima facie** case of anticipation.

35 U.S.C. § 103

With respect to claims 23-25, the examiner relies upon the teachings of Swanson merely to teach the use of a crenulate surface with optical power. (See answer at page 6.) Appellant argues that Swanson does not teach the limitation of a single optical component on one side of a support and the optical component being an integral condenser lens and heat absorbing filter. (See brief at page 4.) We agree with appellant. The examiner has not identified why one skilled in the art would have been motivated to use a single component in the manner claimed, as discussed above. The examiner maintains that if Iwasaki does not teach or suggest the use of a single optical element, then Swanson is believed to fairly suggest integration of plural lens into a single lens element. (See answer at pages 9 and 10.) We disagree with the examiner's conclusion. The examiner has provided no convincing line of reasoning for this conclusion in either the statement of the rejection at page 6 of the answer or in response to appellant's arguments at pages 9-10 of the answer. The examiner merely relies on sections of Swanson identified by the examiner as pertaining to the correction of aberrations. (See answer at page 6 and §§ 5.2 and 5.3 of Swanson.) Appellant argues that there is no motivation to correct aberrations in the system of Iwasaki since there is no image. (See brief at page 5.) We agree with appellant.

With respect to the combination of Dey and Merko, appellant argues that Dey does not disclose a condenser lens element which is spaced from the support. (See brief at page 5.) We agree with appellant. The examiner maintains that Merko

teaches the combination of the condenser lens with the heat absorbing filter. Appellant argues that Merko is not analogous art for the combination and further does not teach the use thereof spaced from a support. (See brief at page 6.) While we agree with the examiner that Merko suggests this combination of the two elements, we find no convincing line of reasoning to combine the projection system of Dey with the generic light modifier of Merko. Therefore, we cannot sustain the rejection of claims 22-25, 36 and 37 over Dey and Merko.

With respect to independent claim 26, appellant presents the same basic arguments found persuasive above. Therefore, we find these arguments persuasive also with respect to independent claim 26 and its dependent claim 38.

CONCLUSION

To summarize, the decision of the examiner to reject claim 22 under 35 U.S.C. § 102 is reversed, and decision of the examiner to reject claims 23-26 and 36-38 under 35 U.S.C. § 103 is reversed.

Appeal No. 1999-2342
Application No. 08/855,556

REVERSED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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MILTON S. SALES
PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER , NY 14650-2201